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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,905	05/04/2001	David Alan Witt	13946(END-696)	9106

7590 10/19/2004

Leopold Presser, Esq.  
Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, NY 11530

EXAMINER

ODLAND, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/849,905

Applicant(s)

WITT ET AL.

Examiner

Kathryn Odland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment/RCE***

This is a response to the Amendment/RCE dated August 31, 2004. Claims 18-28 are under consideration.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 18-22 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Olympus Optical in JP 8275952.

Regarding claim 18, Olympus Optical discloses an ultrasonic surgical instrument having a housing (such as 2, 3); a tubular sheath (such as 5, 20) defining a longitudinal axis and having a proximal end joined to the housing and a distal end; an ultrasonic blade extender (via 4 and associated components) reciprocally positioned within the tubular sheath (5, 20) and having a blade (11 and 14 in connection), the blade having a proximal end and a distal end, and extending distally of the distal end of the tubular sheath; and a clamp arm (via 12) pivotally connected to the proximal end of the blade, as discussed in the abstract and seen in figures 1 and 2.

Regarding claim 19, Olympus Optical discloses that as applied to claim 18, as well as a blade extender (via 4) that is operatively connected to an operating lever for imparting axial

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reciprocable displacement between the blade extender and the tubular sheath, as seen in the figures.

Regarding claim 20, Olympus Optical discloses that as applied to claim 18, as well as a blade is detachably fastened to the blade extender (via 19, etc.).

Regarding claim 21, Olympus Optical discloses that as applied to claim 20, as well as a proximal end of the blade that is a screw threaded connection (via 19).

Regarding claim 22, Olympus Optical discloses that as applied to claim 18, as well as a clamp arm that is pivotally connected to the blade at a nodal point.

Regarding claim 24, Olympus Optical discloses an ultrasonic surgical instrument having a housing (such as 2, 3); an operating lever pivotally connected the housing, a tubular sheath (via 5 and 20) defining a longitudinal axis and having a proximal end operatively connected to the operating lever, and a distal end reciprocally positioned around an ultrasonic blade extender (via 4 and associated components) positioned within the tubular sheath, the blade extender having a blade (such as 11 and 14 in connection), the blade having a proximal end and a distal end, and extending distally of the distal end of the tubular sheath; and a clamp arm (such as 12) pivotally connected to the proximal end of the blade (such as 11 and 14 in connection), as recited in the abstract and seen in the figures.

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Regarding claim 25, Olympus Optical discloses that as applied to claim 14, as well as a blade (such as 11 and 14 in connection) that is detachably fastened to the blade extender (such as 4), as seen in figures 1 and 2.

Regarding claim 26, Olympus Optical discloses that as applied to claim 25, as well as a proximal end of the blade is a screw-threaded connection (19).

Regarding claim 27, Olympus Optical discloses that as applied to claim 24, as well as a clamp arm (via 12 and associated) that is pivotally connected to the blade at a nodal point.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olympus Optical in JP 8275952.

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Regarding claims 23 and 28, Olympus Optical discloses that as applied to claims 18 and 24. Further, a proximal portion of the clamp arm that is positioned within an opening at the distal end of the outer sheath would be obvious if not inherent for the purpose of proper blade and arm movement.

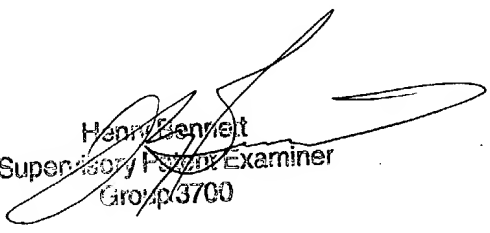
### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO

  
Henry A. Bennett  
Supervisory Patent Examiner  
Group 3700